



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

33

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/637,802	05/08/1996	ANTHONY P. ECCLES	C-35469	4934

7590 08/20/2003

DVORAK AND TRAUB
53 WEST JACKSON BOULEVARD
CHICAGO, IL 60604

[REDACTED] EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/637,802	ECCLES, ANTHONY P.	
	Examiner John P. Sheehan	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 May 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 24-46 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 24-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 2, 2003 has been entered.

2.

Claim Rejections - 35 USC § 112

3. Claims 33 and 36 to 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- I. The subject matter recited in claim 33 does not find support in the specification as filed and therefore is considered drawn to new matter.
- II. The alloy compositions recited in claims 36 to 46 do not find support in the specification as filed and therefore are considered drawn to new matter.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 to 37, 39 and 41 to 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bernard et al. '479** taken in view of **Rateau et al. (Great Britain patent document 2,255,348)**.

Bernard et al. '479 teaches reduced fire scale silver-copper alloys (column 2, lines 24 to 34) consisting essentially of, in weight percent,

silver	89.3 to 93.5%
copper	0.5 to 6%
zinc	0.5 to 5%
silicon	0.1 to 2%
boron	0.001 to 2%
tin	0.25 to 2%
indium	0.01 to 1.25.

This alloy is made by alloying silver metal with a master alloy (column 2, lines 34 to 37) consisting essentially of, in weight percent,

silicon	0.9 to 30.7%
boron	0.001 to 30.7%
zinc	4.5 to 76.9%

Art Unit: 1742

copper	4.5 to 92.3%
tin	2.2 to 30.7%
indium	0.09 to 19.2%.

Rateau et al. teach that adding 0.5 to 3 % weight germanium to a silver-copper alloy (page 3, lines 2 to 4) improves the hardness (see, for example, page 5, lines 11 to 13, page 6, Table II, Alloys 3 and 4) and the fire scale resistance of a silver-copper alloy (page 4, line 3).

The claims and Bernard et al. '479 differ in that Bernard et al. '479 do not teach the exact proportions for each of the alloy components nor does Bernard et al. '479 teach the use of Germanium.

However, one of ordinary skill in the art at the time the invention was made would have been motivated to add germanium to Bernard et al. '479's alloy so as to improve the hardness and the fire scale resistance of Bernard et al. '479's alloy as taught by Rateau et al. Regarding the overlapping alloy proportions it is the Examiner's position that one of ordinary skill in the art would have considered the invention to have been obvious because the alloys taught by Bernard et al. '479 otherwise overlap applicants' claimed alloy and therefore are considered to establish a *prima facie* case of obviousness, In re Peterson 65 USPQ2d 1379 (CAFC 2003), In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

NOTE: Claims 38 and 40 have not been included in the above prior art rejection in view of the claim limitation, "0.1% by weight germanium" which is considered to

Art Unit: 1742

distinguish over Rateau's germanium proportion of 0.5 to 3%. However, claims 38 and 40 have been rejected as drawn to new matter. If in attempting to overcome the new matter rejection, the germanium content recited in claims 38 and 40 is changed to 0.5% or more the rejection based on the combination of Bernhard and Rateau will be applied to claims 38 and 40.

Response to Arguments

2. Applicant's arguments filed May 2, 2003 have been fully considered but they are not persuasive.
3. Applicant points out that the instant claims recite a work hardenable silver alloy containing no more than 2% weight germanium (applicant's response submitted May 2, 2003, page 6, paragraph 2), however, applicant has not pointed out how these limitations distinguish the claimed alloy from the applied prior art.
4. Applicant, referring to Example 2 of the specification, argues that the alloy containing Ge has a hardness that is 15% higher than the same silver alloy without Ge and that "This is a significant and unexpected increase" (applicant's response submitted May 2, 2003, page 6, paragraph 5). The Examiner is not persuaded. Rateau teaches that the addition of Ge to silver-copper alloys improves the hardness (see, for example, page 5, lines 11 to 13, page 6, Table II, Alloys 3 and 4) of the alloy. Thus, the 15% improvement relied on by applicants in his argument is not unexpected, particularly in that it appears that Rateau's Alloys 3 and 4 in Table II have at least 15% improvement in hardness. Further, in making this argument applicant has relied on but one example

Art Unit: 1742

of the invention. This single example of the instant invention is not considered to be commensurate in scope to the claims, *In re Dill* 202 USPQ 805. General superiority cannot be inferred from the results obtained using a single embodiment of the claimed invention, *In re Greenfield*, 197 USPQ 227, 230.

5: Applicant points out that Rateau et al. is directed to a ternary silver alloy while applicant's instantly claimed alloy contains 5 to 8 components. Applicant then argues that, "There is no suggestion,...that the presence of germanium in multi-component silver alloys would increase hardness, as applicant has discovered." The Examiner is not persuaded. There is no reason to believe nor has applicant advanced any reasons to believe that the addition of germanium to silver-copper alloys as taught by Rateau would not improve the fire scale resistance and hardness of other silver-copper alloys such as Bernard's silver-copper alloy. Further, as set forth by The Board of Patent Appeals and Interferences in the previous Board decision in this application;

"Furthermore, Rateau teaches addition of the germanium to harden a silver-copper alloy while the alloy of Bernhard comprises predominantly silver and copper, with only small amounts of silicon, boron, zinc and tin (Bernhard, col. 2, II, 24-29). Due to the similarities in the alloy compositions and similar uses of Rateau and Bernhard, it would have been expected by one of ordinary skill in the art that the addition of germanium would be beneficial for the advantage of improved hardness. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)" (decision, page 4, lines 5 to 14).

Applicant's argument that the Examiner is "comparing apples to oranges" because Rateau's alloy and the instantly claimed alloy are made by a different process is not persuasive. Applicant's claimed invention is directed to an alloy and not the

Art Unit: 1742

process of making an alloy. Any differences between the disclosed process of making the instantly claimed alloy and the prior art alloy does not lend patentability to the instantly claims alloys.

Applicant's argument that none of Rateau's examples set forth the use of less than 1.5% germanium and that Rateau's disclosed lower limit of 0.5 % is theoretical is not persuasive. The teachings of a reference are not limited to what patentees describe as their own invention nor are the teachings of a reference limited to the preferred embodiments, but rather the teachings of a reference are considered to encompass everything that is taught in a complete reading of the reference including non-preferred embodiment MPEP 2123. Rateau clearly and explicitly teaches adding 0.5 to 3 % weight germanium to a silver-copper alloy improves the hardness and the fire scale resistance of a silver-copper alloy.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1742

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



John P. Sheehan

Primary Examiner

Art Unit 1742

jps